

28. (Original) The composition according to claim 1 formulated as a hair shampoo, a body cleanser or a hand cleanser.
29. (Original) The composition according to claim 2 formulated as a hair shampoo, a body cleaner or a hand cleanser.
30. (Previously added) The composition according to claim 2 wherein said low density oily material is a difatty ester selected from the group consisting of Jojoba oil, oleyl oleate, oleyl erucate and mixtures, thereof.

REMARKS

After entering the instant amendment, claims 1-3 and 5-30 are pending in the present application, claim 4 having been previously cancelled and its subject matter incorporated into amended claim 2 and claim 30 having been previously added. Claims 1, 2 8 and 9 have been amended pursuant to the Examiner's continued rejection of the instant invention over the disclosure of Fowler, U.S. patent no. 5,636,469 ("Fowler"). Applicants believe that with the presentation of the instant amendment and the removal of the Examiner's concern regarding the term "high density aromatic ester emollient or conditioning agent" by simply substituting the term "high density aromatic ester", which is defined in great detail on page 7 of the originally filed specification, the instant application is now in condition for allowance. Support for the amendments to the claims can be found throughout the original specification and claims and in particular at page 7, in the first full paragraph where the term "high density aromatic ester" is described.

The Examiner has rejected claims 1, 11, 13, 16, 18-19 and 28 as being anticipated under 35 U.S.C. §102 by Fowler, et al., U.S. no. 5,635,469 ("Fowler"). For the reasons which are presented below, Applicants respectfully submit that the claims are now in condition for allowance.

The §102 Rejection

The Examiner has rejected claims 1, 11, 13, 16, 18-19 and 28 under 35 U.S.C. §102 as being anticipated by Fowler. Applicants respectfully traverse the Examiner's rejection. In

particular, the Examiner has rejected those claims by arguing that Fowler inherently teaches the presently claimed compositions for the reasons which are stated in paragraph 2 of the office action. In particular, the Examiner cites Examples II and III of Fowler for the proposition that the claims are anticipated. Applicants respectfully traverse the Examiner's rejection.

The present invention relates to certain compositions which are multiple phase surfactant compositions comprising at least two distinct and separate liquid phases upon settling, wherein the compositions comprise a first or lower high density layer comprising at least one high density aromatic ester (as defined in the specification on page 7 as a high density aromatic ester emollient/conditioning agent) having a specific gravity of greater than 1.00 and at least one additional layer comprising a surfactant solution having a specific gravity which is less than the specific gravity of the high density layer. The present invention is directed to compositions which exhibit activity as surfactant compositions having emollient characteristics and a pleasant two-layered liquid presentation. Thus, the present invention relates to compositions which exhibit excellent surfactant and emollient/conditioning characteristics with a superior presentation, that presentation being the separation of the product into at least two distinct liquid layers. Contrary to the Examiner's contention, Fowler does not anticipate the present invention, either literally or inherently. It is respectfully submitted that the Examiner has no basis upon which to continue to maintain the inherency rejection.

Applicants note that the instantly amended claims specifically address the Examiner's concern in the February 2, 2004 Advisory Action that the term "high density aromatic ester emollient or conditioning agent" can be interpreted to embrace a "high density aromatic ester emollient and *any* conditioning agent. Note that the term the Examiner has objected to has been amended to the specific term "high density aromatic ester" which is clearly defined in the first full paragraph on page 7 of the specification. This term clearly is defined to embrace high density aromatic ester emollients and aromatic ester conditioning agents. Thus, in actuality, the claims are much more limited than the Examiner's reading of the claims. The amended claims cannot possibly be interpreted to read on the disclosure of Fowler and no anticipation can be made out.

Fowler teaches foaming cleansing products which can contain, *inter alia*, surfactants as well as emollients/conditioners. However, Fowler does not disclose compositions which are in two distinct liquid layers. Fowler clearly does not specifically or literally disclose such compositions and contrary to the Examiner's contention, there is no inherent disclosure of the present invention. Notwithstanding the Examiner's arguments, there is no evidence that Fowler teaches more than one distinct liquid layer as is claimed in the present invention. Notwithstanding that limitation of Fowler, one need not even address this issue for purposes of recognizing that Fowler is not an anticipating reference.

The Examiner cannot cite *any specific composition which* is disclosed in Fowler which meets the limitations of the claimed invention, especially with the requirement for a high density aromatic ester as that term is defined in the present invention. Rather, the Examiner relies on generic disclosures in Fowler (see paragraph 2 of the October 17, 2003 office action) to argue that one of ordinary skill will essentially "cherry pick" the correct components as claimed in the present application in order to produce a composition as claimed, which is desirably characterized by exhibiting at least two distinct and separate liquid phases. While it is true that one of ordinary skill might be able to pick the proper components of the present invention out of the large number of embodiments which are disclosed in Fowler, it is respectfully submitted that that possibility only occurs as a consequence of the person of ordinary skill having been shown the present invention. Without the teachings of the present invention, the likelihood that one of ordinary skill will reliably and consistently produce the present invention does not exist. This is reliance on impermissible hindsight and is an improper foundation for a rejection.

It is noted in paragraph 4 of the previous October 17 office action that the Examiner cites Examples II-IV as inherently anticipating the present invention. Those compositions cannot possibly anticipate the present invention inasmuch as the present invention is directed to compositions as claimed, which contain at least one high density aromatic ester and a surfactant. The Examiner cites examples which cannot meet the limitations of the claims. In particular, the emollients which the Examiner cites, sodium isostearoyl lactylate or lauryl pidolate are not high density aromatic esters as that term has been defined in the specification at page 7. Indeed, these compounds are not even aromatic esters, let alone high density aromatic esters which form a first

or lower layer, as is required by the claims of the instant invention. Consequently, it cannot be said that Fowler somehow anticipates the present invention *inherently* when the Examiner cites components in examples which are not claimed. Thus, the Examiner has not and cannot cite a single, specifically disclosed composition of Fowler which *necessarily, always and inevitably* meets the limitations of the claims of the present invention. Because the Examiner cannot cite any composition which meets the requirements of the doctrine of inherency as established by relevant caselaw, the Examiner has failed to make out a cogent case that the present invention is unpatentable. The mere possibility that one of ordinary skill might *accidentally* produce the present invention using the components generically disclosed in Fowler does not obviate the deficiencies of the rejection based upon inherency. As such, the present invention is clearly novel over the cited art.

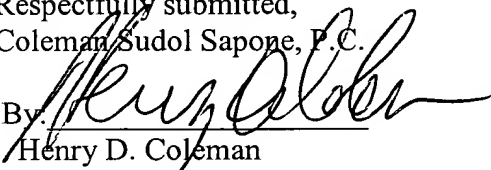
Moreover, nowhere in Fowler is there a disclosure or even an oblique mention of different phases, phase separation, layering, differential phase coloration or component specific gravities, i.e., densities. In short, there is nothing in Fowler which even remotely suggests that Fowler provided a composition or a teaching which gives rise to the present invention. It is respectfully submitted that the Examiner has failed to make out a case that the present invention is inherently anticipated by the present invention.

For all of the above reasons, it is respectfully submitted that the present application is now in condition for allowance and such action is earnestly solicited. No claim has been added or cancelled. No fee is therefore due for the presentation of this amendment. A petition for a one month extension of time is enclosed as is a request for continued examination and a check in the amount of \$440.00. If the Examiner decides that any additional fee is required, or that any credit is due, the Commissioner is authorized to charge any such fee or credit any such overpayment to deposit account 04-0838.

An indication of any charge made to the authorized Deposit Account is respectfully requested at the time of the issuance of a further office action, so that the charge may be accurately tracked for accounting purposes.

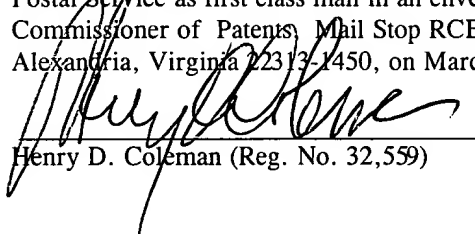
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Respectfully submitted,
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to:
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